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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,088	12/11/2003	Gregory L. Sundberg	279.646USI	7977

21186 7590 08/14/2007  
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MINNEAPOLIS, MN 55402

EXAMINER
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SMITH, TERRI L

ART UNIT	PAPER NUMBER
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3762

MAIL DATE	DELIVERY MODE
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08/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

ED

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/734,088

Applicant(s)

SUNDBERG, GREGORY L.

Examiner

Terri L. Smith

Art Unit

3762

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED on 06 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-3, 5-7, 21 and 23-26.  
Claim(s) withdrawn from consideration: 4, 8-14, 22 and 27-42.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_

GEORGE R. EVANISKO  
PRIMARY EXAMINER

9/13/7

*11 August 2007*

Continuation of 3. NOTE: The insertion of "radially" in claim 3 raises new issues which require further search and consideration..

Continuation of 11. does NOT place the application in condition for allowance because: With regard to Applicant's arguments, prosecution on the merits is closed. Applicant's arguments regarding claim 23 are directed to the amended claim language and the amendment has not been entered. The arguments are related to the new issues which will require further search and consideration. Additionally, Examiner withdraws the 35 U.S.C. 112 first paragraph rejection with the understanding that further search and consideration of the amended language will require further search and consideration which could result in another 35 U.S.C. 112 rejection.

Regarding Applicant's repeated arguments that the prior art of Gardeski and Cross, Jr. do not recite the limitations of claims 1 and 6 (e.g., a conductor that is disposed outside the recesses of a lead body filler" (claim 1) and on or more fillers having a generally C-shape (claim 6)), as recited in Applicant's claims 1 and 6 are not persuasive. Examiner cited specific figures and elements and provided explicit reasons why the citations in each prior art reference (on page 5 and paragraphs 9 and 11 in the Office Action mailed on 05 June 2007) clearly show that the structure of said prior art references meet the claimed limitations as set forth in the present invention. It appears that the Applicant is arguing that because said prior art references do not specifically recite the limitations word for word as presented in the claims, that the prior art does not teach or disclose the claimed limitations as set forth in the current application. It is the Examiner's position that each and every element of the claimed invention has been disclosed and is anticipated by Gardeski and Cross as detailed in said Office Action as noted herein above.

Additionally, Applicant's argument on page 12 stating "(Cross, Jr. at col. 2, lines 35-36). Applicant submits the four radially extending core portions of Cross, Jr. result in a core that is generally X-shaped" is moot given that the cited column and lines do not disclose what Applicant has recited.

With respect to Applicant's arguments on page 11 under the Claims 2-3 heading, Examiner respectfully disagrees. In said Office Action Examiner clearly and specifically recited figures and elements and provided explicit explanations regarding how the citations in the prior art of Cross shows one or more fillers including one or more recesses wherein the one or more recesses include compression features and the compression features include compression waves (on page 5 in paragraph 11). Additionally, regarding Applicant's argument that "the disposition of the conductors into the grooves of Cross, Jr. in conjunction with approximately equal inner tube diameter and outer core diameter does not allow for the presence of compressive recesses (e.g., compression waves) as claimed, Examiner respectfully disagrees. As stated in said Office Action and repeated here: "Applicant has not specifically defined compression in the specification or in the claimed limitation set forth in the present invention. Applicant merely associates a structural feature with compression e.g., page 6, lines 5-6 and 10-12 in the specification. Consequently, it is the Examiner's position that any structure that reads on said limitation as disclosed in said sections of the Applicant's specification would satisfy said limitation."

Further, all of Applicant's arguments pertaining to the 35 U.S.C. 103 rejections are not persuasive. Applicant's statement that "(Gardeski at ... see also col. 10, ln. 67 - col. 11, ln. 2, implying that enhanced torque is provided at the expense of reduced flexibility). In other words, and in contrast to Applicant's claim 21, Gardeski recites an inner filler member having enhanced torque transfer and reduced flexibility properties" is clearly in error. The Gardeski reference as cited by the Applicant clearly recites: "Enhanced flexibility, however, is provided at the expense of reduced torque transfer along that segment." The Applicant has asserted that the Gardeski reference states the EXACT OPPOSITE of what the art actually stated. Consequently, Applicant's argument is moot and in error.

Applicant's arguments against the combination of the Cross, Jr. and Gardeski to reject claim 26 recite portions of the Gardeski reference that Examiner did not rely on to make the combination. Applicant's heavy recitation of portions of the Gardeski art is irrelevant in that Gardeski was merely used to meet the claimed limitation of a coiled conductor and a cable conductor. As stated in said Office Action, Cross, Jr. teaches the structure of the claimed limitation as set forth in the present invention, but was silent on exactly what type/kind of conductors were used. Therefore, the Examiner merely needed to find art in the same field of endeavor that taught the specific conductors as claimed by the present invention to make the obviousness rejection. Gardeski is the art that the Examiner chose and it clearly teaches the type/kind of conductors set forth in the limitation of the present invention. Once again, Examiner explicitly and specifically recited figures and elements and clearly stated the reasons for the rejections on page 7 in paragraph 17 of said Office Action, and Examiner upholds and maintains the rejections as originally presented. As stated in said Office Action: "The test for combining references is what the combination of disclosures taken, as a whole would suggest to one of Ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969."

In view of the arguments and statements presented herein above, Examiner maintains the 35 U.S.C. 102 and 103 rejections as presented in said Office Action.